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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/543,086

07/22/2005

Leopold Murhammer

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EXAMINER

BRANDT, CHRISTOPHER M

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

12/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/543,086	Applicant(s) MURHAMMER ET AL.	
	Examiner CHRISTOPHER M. BRANDT	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/7/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement submitted on November 7, 2008 has been considered by the examiner and made of record in the application file.

Response to Amendment

This Action is in response to applicant's amendment filed on September 29, 2008.

Claims 1-11 are still currently pending in the present application. **This Action is made FINAL.**

Response to Arguments

Applicant's arguments filed September 29, 2008 have been fully considered but they are not persuasive.

With regard to applicant's argument that Tsai fails to disclose checking whether an identification detail **abbreviation** which is stored in a list of such identification detail abbreviations, the examiner respectfully disagrees. Tsai teaches an index code which is equivalent to an abbreviation because it represents phone call data for each user (column 3 lines 60-65). In addition, Tsai discloses an identification type, which is related to each index code because the identification type is phone call data. In addition, the check can check/filter a group of users because Tsai takes advantage of the identification type (column 5 lines 42-48). However, this feature is not required because the claims do not recite intercepting a group or a plurality of telecommunication connections as applicants appear to be indicating.

As a result, the claims are written such that they read upon the cited references.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2, 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Eloranta (WO 01/60098 A1)** in view of **Tsai et al. (US Patent 6,823,049 B2, hereinafter Tsai)**.

Consider **claim 1**. Eloranta discloses a method for deciding whether to intercept a telecommunications connection, comprising:

for an identification detail relating to each of at least one subscriber of the telecommunications connection, checking whether the identification detail is included in at least one identification relating to the subscriber to be monitored which is stored in a list; and

intercepting the telecommunication connection if it is stored in the list (page 5 line 27 – page 6 line 19, page 7 lines 26-27, read as a method for monitoring (intercepting) the communications of a certain equipment or person, wherein for an identification information (preferably MSISDN, IMEI, IMSI) relating to at least one mobile station 1 (figure 1) a check is made for matching entry of identification information, which is stored in database 5 (figure 1) with interception to be based on any of the parameters stored in the database 5).

Although Eloranta discloses the claimed invention, he fails to suggest that the identification detail is associated with at least one identification detail **abbreviation** relating to each of the at least one subscriber.

However, Tsai discloses identification detail is associated with at least one identification detail **abbreviation** relating to each of the at least one subscriber (figure 2, column 3 lines 61-62, column 5 lines 46-48, read as each of the stored phone call data includes an index code (i.e. abbreviation), where the identification code is judged to determine whether or not is has a filtering flag).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teachings of Tsai into the method of Eloranta in order reduce the amount of time required for setting and changing screening conditions (column 6 lines 16-19).

Consider **claim 11**. Eloranta discloses a device for deciding whether to intercept telecommunications connections, comprising:

a list of identification detail relating to telecommunications subscribers to be intercepted stored in a memory;

comparison equipment for comparing identification details transferred over a telecommunications connection relating to subscribers of the telecommunications connection with stored identification detail; and

decision equipment to initiate the monitoring of a telecommunications connection with at least one telecommunications subscriber identified as to be monitored by an identification detail (page 5 line 27 – page 6 line 19, read as a legal interception gateway (LIG) 3 (figure 1) to monitor (intercept) communication connections, with an identifier data relating to a mobile station (figure 1) to be monitored (intercepted) stored in database 5 (figure 1), with matching entry means in the database 5 for identification information cooperates over a communication connection relating to a mobile station 1 with stored identification information, with the legal interception gateway (LIG) 3 to initiate the interception to be based on any of the parameters stored in the database 5).

Although Eloranta discloses the claimed invention, he fails to suggest that the identification detail is associated with at least one identification detail **abbreviation** relating to each of the at least one subscriber.

However, Tsai discloses identification detail is associated with at least one identification detail **abbreviation** relating to each of the at least one subscriber (figure 2, column 3 lines 61-62, column 5 lines 46-48, read as each of the stored phone call data includes an index code (i.e.

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abbreviation), where the identification code is judged to determine whether or not is has a filtering flag).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teachings of Tsai into the method of Eloranta in order reduce the amount of time required for setting and changing screening conditions (column 6 lines 16-19).

Consider **claim 2** and **as applied to claim 1**. Eloranta and Tsai disclose a method wherein the identification detail abbreviation is part of an identification detail relating to a mobile subscriber number (Eloranta; page 5 line 27 – page 6 line 19, page 7 lines 26-371, Tsai; figure 2, column 3 lines 61-62).

Consider **claim 5** and **as applied to claim 1**. Eloranta and Tsai disclose a method wherein the identification detail abbreviation is part of a telecommunications terminal identification (Eloranta; page 5 line 27 – page 6 line 19, page 7 lines 26-37, Tsai; figure 2, column 3 lines 61-62).

Consider **claim 6** and **as applied to claim 1**. Eloranta and Tsai disclose a method wherein the telecommunications connection is routed over a mobile radio network and/or fixed network and/or the Internet (Eloranta; page 5 lines 10-25).

Consider **claim 7** and **as applied to claim 1**. Eloranta and Tsai disclose a method wherein the checking is undertaken by equipment of a telecommunications network over which the telecommunications connection is routed or by equipment connected to it (Eloranta; pages 6 lines 8-19).

Consider **claim 8** and **as applied to claim 1**. Eloranta and Tsai disclose a method wherein the interception is undertaken by official equipment (Eloranta; page 5 lines 27 – page 6 line 6).

Consider **claim 9** and **as applied to claim 1**. Eloranta and Tsai disclose a method wherein identification details are checked when a connection is set up (Eloranta; page 6 lines 8-19).

Consider **claim 10** and **as applied to claim 1**. Eloranta and Tsai disclose a method wherein identification details of telecommunications subscribers are checked on transmission of data packets over a telecommunications connection (Eloranta; page 5 lines 10-25).

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Eloranta (WO 01/60098 A1)** in view of **Tsai et al. (US Patent 6,823,049 B2, hereinafter Tsai)** and further in view of **Helferich (US Patent 6,826,407)**.

Consider **claim 3** and **as applied to claim 1**. Eloranta and Tsai disclose the claimed invention except wherein the identification detail abbreviation is part of an e-mail address.

However, Helferich discloses a method wherein an identification detail abbreviation is part of an e-mail address of a telecommunications subscriber (abstract, column 9 lines 34-49, read as the replay address may be an e-mail address or an abbreviated e-mail address that is associated with an e-mail address stored at the IMG 150. It is also noted from the abstract that this invention does in fact relate to a mobile communication device for receiving visual messages (e-mails)).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teachings of Helferich into the methods of Eloranta and Tsai in order to be able to monitor all possible transmissions of information.

Consider **claim 4** and **as applied to claim 3**. Eloranta, Tsai, and Helferich disclose a method wherein the identification detail abbreviation is a domain name or a part of a domain name in an e-mail address of a telecommunications subscriber (Helferich; column 9 lines 34-49).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street

Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Brandt whose telephone number is (571) 270-1098.

The examiner can normally be reached on 7:30a.m. to 5p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

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Christopher M. Brandt

C.M.B./cmb

December 11, 2008

/George Eng/

Supervisory Patent Examiner, Art Unit 2617